

REMARKS

Introduction

Claims 1-3, 6, 8, 10-12, 14-15, 17-20, 22-23, 25-26, 28-29, 31-33, 35-40, 44-45, and 74-75 are pending. Claims 1 and 37 have been amended. Support for these amendments can be found throughout the specification, for example, in the claims as filed, paragraph [0035], and in the examples.

Claims 4-5, 7, 9, 13, 16, 21, 24, 27, 30, 34, 41-43, 46-73 have been cancelled without prejudice to the subject matter therein. Applicant expressly reserves the right to pursue these claims in a later application or in this application via rejoinder.

Rejections under 35 U.S.C. §102

A. The Biedermann *et al.* rejection

The Examiner has rejected claims 1, 10, 17, 18, 35, 74 and 75 under 35 U.S.C. §102(a,e) as allegedly being anticipated by U.S. Patent Number 5,980,921 issued to Beidermann *et al.* (the '921 patent). Applicants respectfully disagree.

However, solely to expedite prosecution, independent claim 1 has been amended to recite that the composition comprises a film former in at least one non-aqueous vehicle. The '921 patent uses water in oil emulsions which are not non-aqueous vehicles. See, e.g., claim 1 of the '921 patent. The '921 patent further states that its purported film-forming embodiments "contain a film forming polymer/plasticizing solvent in the aqueous (internal) phase of the emulsion." See col. 8, ll. 34-36. It continues that "[t]he combination of an aqueous phase polymer and solvent is chosen to provide proper evaporation rate and polymer solvation" to delay the onset of tackiness. See col. 8, ll. 38-42. Thus, the '921 patent does not disclose film forming compositions having a film former in a non-aqueous vehicle.

Further, independent claims 1 and 37 have both been amended to also recite that the composition comprises "at least one film former comprising from about 0.0001% to about 10% of the composition." This feature is not disclosed in the '921 patent in combination with the other claimed features, for example, with the use of a non-aqueous vehicle to form a film.

The amended claims further recite that the composition forms "a stable, breathable film upon application to a surface." As outlined above, the amended claims are directed to compositions having combinations of specific amounts of components which are not disclosed in the '921 patent. Applicant respectfully notes that the Examiner's assertion that the limitations are inherently taught by the '921 patent and that it "teaches a topical sprayed composition comprising the same components in identical concentrations" to the claims is not accurate. Office Action at pg. 5. Thus, there is insufficient evidence to establish that the '921 patent's compositions containing different components than those claimed will always, thus inherently, form a stable, breathable film. Therefore, a proper inherency rejection has not been established.

For at least these reasons, the '921 patent does not anticipate amended claim 1 and/or claim 37 or their dependent claims. Applicant respectfully requests that this rejection be withdrawn.

B. The Osipow *et al.* rejection

The Examiner has rejected claims 1-4, 6, 8, 10-12, 14, 15, 17-20, 22, 23, 25, 26, 28, 29, 31-33, 35-40, 44 and 45 under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent 4,328,319 issued to Osipow *et al.* (the '319 patent). Applicants respectfully disagree.

The Examiner has taken the position that the foams of the '319 patent would constitute a film of material as applied to the skin. However, foams and films are distinguished in the reference. The '319 patent is directed to foam applicators and not to stable, breathable films as is claimed in independent claims 1 and 37. See, e.g., col. 11, ll. 38-50; col. 13, ll. 43-53; and col. 14, ll. 29-61. The '319 patent itself recognizes the distinction between its foam applicator compositions and films such as those claimed, stating that foam compositions "differ from . . . [compositions that] can be spread out to a film that may be only a few mils thick. . ." See col. 15, ll. 5-11. Thus, Applicants

respectfully disagree with the Examiner's assertion that the compositions of the '319 patent can be treated as a film or that the compositions always, thus inherently, form a stable, breathable film.

However, solely to expedite prosecution, independent claims 1 and 37 have been amended to recite that the composition comprises "at least one film former comprising from about 0.0001% to about 10% of the composition." This feature is not disclosed in the '319 patent. Instead, the '319 patent states that if the amount of polymer is too low (less than approximately 10% by weight of the composition) then "a cohesive foamed structure is not formed, but instead a cohesive, sticky, flowable mass is obtained." See, e.g., col. 9, ll. 44-47. This further distinguishes the foams of the reference from the presently claimed films. Also, this language teaches away from the use of low concentrations of film former required by the present claims. Thus, the '319 discloses the need to use more than approximately 10% by weight of the polymer, while the claims are directed to amounts less than 10%.

For at least these reasons, the '319 patent does not anticipate amended claim 1 and/or claim 37 or their dependent claims. Applicant respectfully requests that this rejection be withdrawn.

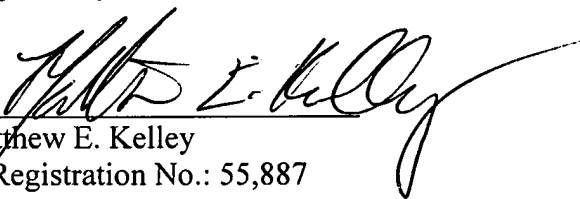
CONCLUSION

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. Accordingly, Applicants request that the Examiner issue a Notice of Allowance indicating the allowability of claims 1-3, 6, 8, 10-12, 14-15, 17-20, 22-23, 25-26, 28-29, 31-33, 35-40, 44-45, and 74-75 and that the application be passed to issue. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

The Commissioner is authorized to charge any deficiency in any patent application processing fees pursuant to 37 CFR §1.17, including extension of time fees pursuant to 37 CFR §1.17(a)-(d), associated with this communication and to credit any excess payment to Deposit Account No. 22-0261.

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